

REMARKS

The Applicant thanks the Examiner for his detailed comments. Amendments have been made to the claims. Entry of the Amendments is respectfully requested. Claim 2 is cancelled.

Line 9 of the office action summary objects to the specification but no reasons for the objection were presented. In the previous amendment, amendments to the abstract, drawings and specification were made but were not acknowledged by the examiner in this office action. Withdrawal of the objection is earnestly requested based on the previous amendments.

Interview

Applicant thanks Examiner for the Office Action mailed August 11, 2005 and for the brief interview granted. The telephone interview with Examiner Blanco on December 9, 2005 discussed the meaning of segmented shells. Specifically, it was agreed that segmented shells have separate pieces which form a shell, such that the separate pieces may be inserted through a tube into the body and assembled into a shell. The shaft and shell are used in minimally invasive hip replacement surgery, and this definition of segmented is clearly supported in the specification of the present invention.

Formalities

Now referring to paragraph 3 of the office action, claim 1 has been amended to incorporate the Examiner's comments.

Claims 1, 3, and 4, as amended, are generic, and the elected species of Fig. 15 incorporates the limitations of each of the claims and additional limitations. Specifically, pg. 18 of the specification, lines 18-19, discloses that in the embodiment shown in Figs. 15 and 27, this third embodiment, the "...shaft 715 is very similar in structure to the shaft 114.." of Figs. 1-2. The amendment to claim 1 merely incorporates a limitation regarding the shaft from claim 2 into claim 1.

Office Action

Now referring to paragraph 4 of the office action, Claim 1 has been amended to incorporate a limitation from claim 2, putting claim 1 in condition for allowance and in a better position for appeal. Applicant reserves the right to file a divisional or continuation application to claim the subject matter in claim 1. A Notice of Appeal is filed with this Office Action, in order to ensure timely filing; however, applicant is prepared to his representative discuss the amendment with the Examiner prior to filing an Appeal Brief, if possible.

FIG. 29

Grimes

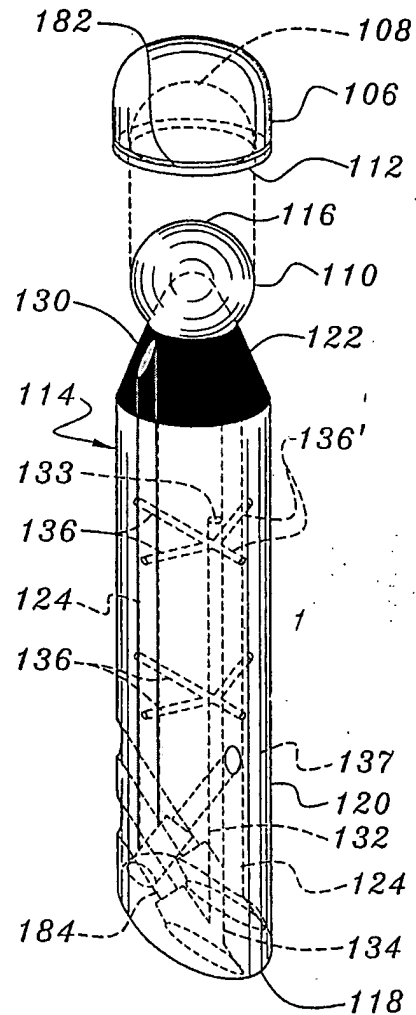
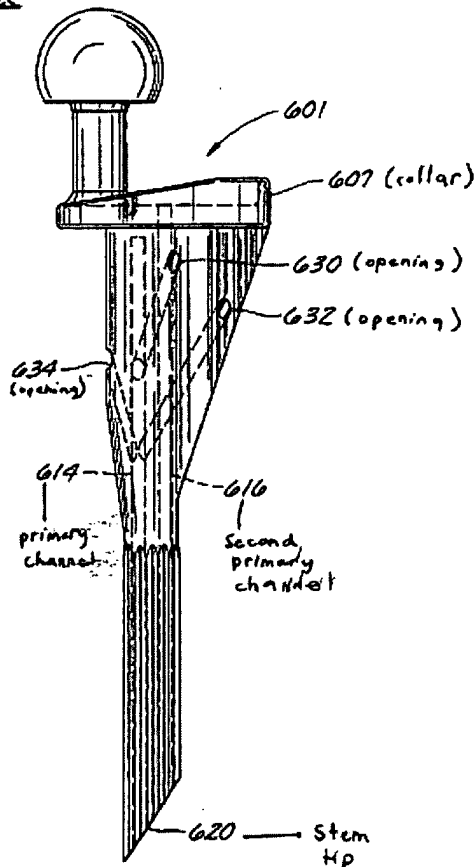


FIG. 12

Now referring to the office action, paragraph 7, in view of the amendment of claim 1, the combination of Hyde and Grimes fails to establish *prima facie* obviousness. In order to establish *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest every limitation of the

invention. The combination of Hyde and Grimes fails to teach or suggest every limitation of claim 1 as amended. Neither Hyde nor Grimes teaches or suggests a shaft having..., "at least one channel passing through said body of said shaft such that said at least one channel extends through said body to an open end of said at least one channel, said open end being disposed at an area external to said neck and adjacent to said neck,....said shaft being sized and configured to be inserted through a hole bored through a first bone of a patient" and "a prosthetic socket comprising a plurality of segments, said segments being sized and configured for attachment to a prepared area on a second bone of the patient and for insertion through said hole bored through said first bone of a patient," as recited in amended claim 1.

First, Hyde does not show any channels. Second, Grimes generally discloses channels which vent the implant-bone interface. (pg. 46, lns. 10-14.) Additionally, Figure 29 of Grimes (figure depicted above) shows a channel having a *closed end*, which is *short of the area at the neck of the prosthesis*. The only open channel ends 630, 632 extend from the body in an area far from the neck, which is the region shown above the collar 607. The neck is described as having a lower portion 5B mounted on a collar 7, as shown in Figure 1 of Grimes. By contrast, an example of the present invention is shown in Figure 12 of the applicant's patent application. An "open end of a channel extending" to "an area external to the neck and adjacent to the neck." (Figure 12 shows the neck highlighted in gray.) This example compares the differences between the channels in Grimes and the claimed channels. Thus, neither Hyde nor Grimes teaches or suggests all of the limitations; therefore, the combination fails to establish *prima facie* obviousness.

Claim 2 is cancelled and claim 3 is amended to depend from claim 1. Claim 3 includes all of the limitations of claim 1 and additional limitations. Therefore, claim 3 is nonobvious and in condition for allowance. Claim 4 depends from and incorporates the limitations of claim 1 and additional limitations. Therefore, claim 4 is in condition for allowance.

The amendments to the claims now put the application in condition for allowance. The Applicant respectfully requests that the Examiner enter the amendments and indicate allowance of the claims that are now pending in this application.

Now referring to paragraph 8 of the office action, making the present action final is premature and Applicant requests reconsideration. Applicant traversed Grimes on the basis that Grimes failed to disclose any prosthetic socket having a plurality of segments. While applicant made amendments to claim 1 to clarify the relationship between the prosthetic socket and the shaft in the previous response, these clarifying amendments did not necessitate the new grounds for rejection in the present office action. Instead, the new grounds were necessitated on the failure of Grimes to disclose any prosthetic socket having a plurality of segments. Thus, Grimes failed to establish prima facie anticipation, because it did not disclose each and every element of claim 1, exactly, even in its amended state. This is shown by the introduction of Hyde as new grounds for rejection, which was not necessitated by the amendment to claim 1.

Claims 1, 3, and 4, as amended, are generic, and the elected species of Fig. 15 incorporates the limitations of each of the claims and additional limitations. Specifically, pg. 18 of the specification, lines 18-19, discloses that in the embodiment shown in Figs. 15 and 27, this third embodiment, the "...shaft 715 is very similar in structure to the shaft 114.." of Figs. 1-2.

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